

**REMARKS**

Claims 1-16 and 18-22 are pending in this application. Reconsideration of the rejections is respectfully requested.

Applicants appreciate the courtesies extended to Applicants' representative during the October 2 telephone conference with Examiner Kim.

The Office Action objects to drawing figures 33 and 34. In response, Applicants have submitted a Letter to the Official Draftsperson which includes formal drawings for all figures 1-34. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

**I. Double Patenting Rejection**

The Office Action rejects claims 1-16 and 18-22 under the judicially created doctrine of obviousness-type double patenting over claims 1-120 of U.S. Patent 6,195,093 to Nelson et al. In order to overcome the rejection Applicants have submitted a Terminal Disclaimer which disclaims any patent term extending beyond September 14, 2018, the expiration date of the '093 patent. Accordingly, Applicants respectfully request that the obviousness-type double patenting rejection of claims 1-16 and 18-22 be withdrawn.

**II. Art Rejection**

The Office Action rejects claims 1-16 and 18-22 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 5,960,448 to Reich et al. (hereinafter "Reich") in view of U.S. Patent 5,144,114 to Wittensoldner et al. (hereinafter "Wittensoldner"). Applicants respectfully traverse the rejection.

In particular, Applicants submit that neither of the applied references disclose or suggest a system that controls a presentation using a tangible, sensible identification-carrying device comprising at least one presentation element identifier that identifies at least one presentation element, the system comprising, *inter alia*, a sensor that senses the at least one

presentation element identifier and at least one control element identifier for controlling the presentation element identified by the at least one presentation element identifier, as recited in independent claim 1 and similarly recited in independent claims 9, 16 and 22.

In contrast, Reichek discloses a system for controlling a presentation wherein a barcode scanner senses a barcoded presentation element identifier on a document. A controller recognizes the scanned barcode and identifies it with a presentation element. The presentation element is then displayed on a display device. However, as admitted in the Office Action, Reichek fails to teach the presence of a control element identifier for controlling the presentation element identified by the at least one presentation element identifier.

The Office Action relies upon Wittensoldner to teach a control element identifier. However, in Wittensoldner, a barcode is used to increase the volume of a device attached to a barcode scanner. For example, in a grocery store, a clerk places a barcode card over a barcode scanner to cause the output volume of a speaker attached to the scanning device to increase. The Office Action alleges that based on the disclosure of Wittensoldner, it would have been obvious to modify Reichek to make use of this feature. However, Applicants respectfully submit that merely adding a volume control device based on a barcode to the system of Reichek would fall short of the claimed invention. In Wittensoldner the barcode for increasing the volume is completely unrelated any individual element being scanned by the scanner, such as groceries. Wittensoldner affects a universal change to the system by increasing the volume. Thus, the control element in Wittensoldner is not for controlling the element identified by the element identifier. Therefore, the combination of Wittensoldner and Reichek fails to establish a prima facie case of obviousness over the claimed invention.

Moreover, the only motivation to combine Wittensoldner with Reichek and to extend the capability of Wittensoldner so that not only the volume of the device would be used, but that the presentation element itself would be controlled by the barcode, is the disclosure of

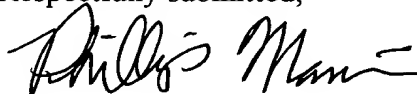
Applicants' invention. Thus, the rejection of the claims based on Reichek in view of Wittensoldner is founded on improper hindsight reconstruction of the claimed invention, and yet still falls short of reaching the claimed invention. Accordingly, Applicants respectfully submit that claims 1, 9, 16, 21 and 22 are patentable over the combination of applied references. Dependent claims 2-8, 10-15 and 18-20 are likewise patentable over the combination of applied references for at least the same reasons as independent claims 1, 9, 16, 21 and 22. Accordingly, Applicants respectfully request that the rejection of claims 1-16 and 18-22 under 35 U.S.C. §103(a) be withdrawn.

### III. Conclusion

Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-16 and 18-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Terminal Disclaimer

Letter to the Official Draftsperson

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